UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/489,171	01/21/2000	Frank A. Doljack	DOLJP103WOUSA	5489

7590 05/20/2005	EXAMINER
Warren A Sklar	CALLAHAN, PAUL E
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ART UNIT	PAPER NUMBER
2137	

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DATE MAILED: 05/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _2-3-2005_.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _44-67 and 77-107_ is/are pending in the application.

　4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) _100 and 101_ is/are allowed.

6)☐ Claim(s) _44-52,61,63,65-67,77-86,88-93,97-99 and 102-105_ is/are rejected.

7)☐ Claim(s) _53-60,62,64,87,94-96,106 and 107_ is/are objected to.

8)☐ Claim(s) _68-76 and 108-111_ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on _12 January 2000_ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

　Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

　Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

　a)☐ All b)☐ Some * c)☐ None of:

　　1.☐ Certified copies of the priority documents have been received.

　　2.☐ Certified copies of the priority documents have been received in Application No. _____.

　　3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
　　　　application from the International Bureau (PCT Rule 17.2(a)).

　* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____. *p.C.*

4)☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1.   Applicant's election without traverse of claims of Group I including Claims 44-67

and 77-107 in the reply filed on February 3rd, 2005 is acknowledged.

2.   Claims 44-67 and 77-107 have been examined.

Specification

3.   Claim 88 is objected to because of the following informalities: The claim is

dependent upon a cancelled base claim. Appropriate correction is required.

Double Patenting

4.   The nonstatutory double patenting rejection is based on a judicially created
doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the
unjustified or improper timewise extension of the "right to exclude" granted by a patent
and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11
F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225
USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA
1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*,
418 F.2d 528, 163 USPQ 644 (CCPA 1969).
        A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be
used to overcome an actual or provisional rejection based on a nonstatutory double
patenting ground provided the conflicting application or patent is shown to be commonly
owned with this application. See 37 CFR 1.130(b).
        Effective January 1, 1994, a registered attorney or agent of record may sign a
terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with
37 CFR 3.73(b).

5.   Claim 44 is rejected under the judicially created doctrine of obviousness-type

double patenting as being unpatentable over claims 24 and 27 of U.S. Patent No.

6,442,276. Although the conflicting claims are not identical, they are not patentably

distinct from each other because they each claim identical methods for verifying the

authenticity of goods, with substantially the same claim language used to claim identical

method steps.

Claim Rejections - 35 USC § 102(b)

6.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7.   Claims 97 and 98 are rejected under 35 U.S.C. 102(b) as being clearly

anticipated by Gilham US 4,934,846.

Gilham teaches a method of verifying authenticity or other information of goods

or the like using an encrypted code (abstract), comprising determining whether an

encrypted code is present, determining whether the code when decrypted matches a

prescribed code (fig. 2, col. 2 lines 8-29), and determining whether the matched

prescribed code is a duplicate and if a duplicate, indicating that at least one or the other

of the goods is a duplicate (col. 4 lines 4-10, Pseudo-random numbers selected in

sequence, fig. 2 "Fault").

Claim Rejections - 35 USC § 103

8.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

9.   Claims 44-52, 65-67, 99, 106, and 107 are rejected under 35 U.S.C. 103(a) as

being unpatentable over Storch et al., US 5,367,148, and Gilham.

As for claims 44, 47, and 97, Storch teaches a method for verifying the

authenticity of goods (abstract), comprising the steps of generating one or more

combination codes wherein each has a random portion and a non-random portion (col.

4 lines 37-42), associating the combination codes with one or more goods (col. 4 lines

44-50), wherein each of the goods has a unique combination code (col. 4 lines 44-50);

and examining goods to verify whether they are authentic (col. 5 lines 18-28), wherein

examining the goods comprises: reading the code associated with one of the one or

more goods (col. 5 lines 20-30); and evaluating the code to verify whether the good is

authentic (col. 5 lines 20-30).

Storch does not teach encrypting the combination code, or a step for verifying the

authenticity of the goods by reading an encrypted combination code, decrypting it, and

comparing it to a stored version of the combination code. However Gilham does teach

these steps (abstract, fig. 3) therefore it would have been obvious to one of ordinary skill

in the art at the time of the invention to have incorporated this step into the method of

Storch. Motivation to make this combination is found for example, at col. 16 lines 5-8,

where Storch discusses the desirability of providing ID numbers verifiable by a secret

algorithm.

As for claim 45, Storch teaches the step of generating one or more combination

codes wherein the step comprises the steps of: generating one or more random codes;

and combining the one or more random codes with a non-random code (abstract).

As for claim 46, Storch teaches a step of combining wherein combining the one

or more random codes with a non-random code is selected from the group consisting of

concatenating the non-random code to an end of the random code, concatenating the

non-random code to a beginning of the random code and interposing the non-random

code within the random code (abstract, col. 4 lines 37-44).

As for claim 48, Storch teaches a step of reading the code that comprises

scanning the code (col. 4 line 35).

As for claim 49, Storch does not teach a step wherein the evaluating of the

decrypted code comprises determining whether the decrypted code contains the non-

random portion of the combination codes. Gilham does teach evaluation of the non-

random portion of a combined code after decryption (fig. 3, col. 5 lines 25-40).

Therefore it would have been obvious to one of ordinary skill in the art to incorporate this step into the method of Storch. Motivation to make this combination is found for example, at col. 16 lines 5-8, where Storch discusses the desirability of providing ID numbers verifiable by a secret algorithm.

As for claim 50, Storch does not teach a step of determining whether the decrypted code contains the non-random portion that comprises visually inspecting the decrypted code. However Gilham does teach this (col. 5 line 48). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate this feature into the system of Storch. Motive to make this combination is found for example at col. 2 line 25 of Storch where the reliance on mechanical means is discussed.

As for claim 51, Storch does not teach a method wherein the step of evaluating the decrypted code comprises comparing the decrypted code to the non-random portion of the combination codes. Gilham does teach evaluation of the non-random portion of a combined code after decryption (fig. 3, col. 5 lines 25-40). Therefore it would have been obvious to one of ordinary skill in the art to incorporate this step into the method of Storch. Motivation to make this combination is found for example, at col. 16 lines 5-8, where Storch discusses the desirability of providing ID numbers verifiable by a secret algorithm.

As for claim 52, Storch teaches a method comprising the step of determining whether the combination code has been previously used if the random portion matches a portion of the code (col. 4 line 29). Storch does not teach encryption and decryption of the combined code. Gilham does teach evaluation of the combined code after decryption (fig. 3, col. 5 lines 25-40). Therefore it would have been obvious to one of ordinary skill in the art to incorporate this step into the method of Storch. Motivation to make this combination is found for example, at col. 16 lines 5-8, where Storch discusses the desirability of providing ID numbers verifiable by a secret algorithm.

As for claim 65, Storch teaches a method step wherein associating the encrypted combination codes with one or more goods comprises applying the encrypted combination codes to the one or more goods (col. 4 line 44-54).

As for claim 66, Storch teaches a method step wherein examining the goods comprises: determining whether the code matches a prescribed code (col. 4 lines 25-35); and indicating whether the matched prescribed code is a duplicate based on the determination (col. 4 line 25-35). Storch does not teach encryption and decryption of the combined code. Gilham does teach evaluation of the combined code after decryption (fig. 3, col. 5 lines 25-40). Therefore it would have been obvious to one of ordinary skill in the art to incorporate this step into the method of Storch. Motivation to make this combination is found for example, at col. 16 lines 5-8, where Storch discusses the desirability of providing ID numbers verifiable by a secret algorithm.

As for claim 67, Storch teaches a method step wherein examining the goods comprises: determining whether the code a prescribed code (col. 4 lines 25-35); and indicating that a counterfeit has been detected if the prescribed code is a duplicate (col. 4 lines 25-35). Storch does not teach encryption and decryption of the combined code. Gilham does teach evaluation of the combined code after decryption (fig. 3, col. 5 lines 25-40). Therefore it would have been obvious to one of ordinary skill in the art to incorporate this step into the method of Storch. Motivation to make this combination is found for example, at col. 16 lines 5-8, where Storch discusses the desirability of providing ID numbers verifiable by a secret algorithm.

As for claim 99, Storch teaches a method of coded labeling of goods, process or the like (abstract), comprising obtaining a random number, alphanumeric or the like code and a further non-random string, alphanumeric, or the like code; coupling the codes to obtain a combination code with a random portion arid a non-random, label portion (col. 4 lines 37-44); applying or associating the combination code to or associating it with goods, process or the like (col. 4 lines 44-50); and verifying authenticity of the goods, process or the like or of some characteristic thereof by determining whether the non-random label portion is found and/or is correct (col. 5 lines 18-28). Storch does not teach encrypting the combination code, and decrypting it prior to verification. Gilham however, does teach these steps (abstract, fig. 3, col. 2 lines 20-30). Therefore it would have been obvious to one of ordinary skill in the art to incorporate this step into the method of Storch. Motivation to make this combination is

found for example, at col. 16 lines 5-8, where Storch discusses the desirability of

providing ID numbers verifiable by a secret algorithm.

10.   Claims 61, 63, 77-86, 88-93, and 102-105 are rejected under 35 U.S.C. 103(a)

as being unpatentable over Storch and Gilham, and further in view of Venkatesan et al.,

US 6,209,093.

        As for claims 77 and 84, Storch teaches a method of identifying items,

comprising associating with respective items respective combination codes or indicia,

each composed of a unique random portion and a non-random portion (abstract),

Storch fails to teach an encrypted combination code. However Gilham does teach this

step (abstract, fig. 3). Therefore it would have been obvious to one of ordinary skill in

the art at the time of the invention to incorporate this step into the method of Storch.

Motivation to make this combination is found for example, at col. 16 lines 5-8, where

Storch discusses the desirability of providing ID numbers verifiable by a secret

algorithm. The combination of Storch and Gilham fails to teach a step wherein the

nonrandom portion includes at least a secret portion that is encrypted. However

Venkatesan does teach this feature (fig. I item 87). Therefore it would have been

obvious to one of ordinary skill in the art at the time of the invention to incorporate this

step into the system of Storch and Gilham. Motivation to make this combination is found

for example, at col. 16 lines 5-8, where Storch discusses the desirability of providing ID

numbers verifiable by a secret algorithm

As for claims 78, 85, and 91, the combination of Storch and Gilham fails to teach a step where the secret portion is encrypted with a public key and can be decrypted with a corresponding private key. However Venkatesan does teach this feature (abstract) Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate this step into the system of Storch and Gilham. Motivation to make this combination is found for example, at col. 16 lines 5-8, where Storch discusses the desirability of providing ID numbers verifiable by a secret algorithm.

As for claims 79, 86, and 92, the combination of Storch and Gilham does not teach a step wherein the non-random portion of the combination code includes a secret encrypted portion containing tracking information. However Venkatesan does teach this feature (col. 4 lines 47-54: Indicia printed on product). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate this step into the system of Storch and Gilham. Motivation to make this combination is found for example, at col. 16 lines 5-8, where Storch discusses the desirability of providing ID numbers verifiable by a secret algorithm.

As for claims 80, 88, and 93, Storch fails to teach a step comprising decrypting the combination code; However Gilham does teach evaluation of the a combined code after decryption (fig. 3, col. 5 lines 25-40). Therefore it would have been obvious to one of ordinary skill in the art to incorporate this step into the method of Storch. Motivation to make this combination is found for example, at col. 16 lines 5-8, where Storch

discusses the desirability of providing ID numbers verifiable by a secret algorithm. The

combination of Storch and Gilham fails to teach decrypting the secret portion of the

decrypted combination code to determine the tracking information or information about

the product. However Venkatesan does teach this step at (col. 13 line 65, col. 14 line 5)

Therefore it would have been obvious to one of ordinary skill in the art at the time of the

invention to have incorporated this step into the system of Storch and Gilham.

Motivation to make this combination is found for example, at col. 16 lines 5-8, where

Storch discusses the desirability of providing ID numbers verifiable by a secret

algorithm.

As for claims 81-83, Storch teaches a step of associating comprising applying the

respective combination codes in the form of bar codes or alphanumeric symbols to

respective items or labels associated with the items (fig. 2)

As for claim 89, Storch teaches selecting the non-random portion as at least one

of a readable word, number or alphanumeric (col. 4 lines 37-44).

As for claims 61, 63, 90, 102, and 103, Storch teaches a method of checking

authentication of an item identified by a combination code, each combination code

including a unique random portion and a non-random portion (col. 4 lines 37-44). Storch

does not teach that the nonrandom portion includes at least a secret portion containing

tracking information that is encrypted. However Venkatesan does teach this step (fig. 1

item 87). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate this step into the system of Storch. Motivation to make this combination is found for example, (col. 16 lines 5-8), where Storch discusses the desirability of providing ID numbers verifiable by a secret algorithm. The combination of Storch and Venkatesan does not teach an encrypted combination code or checking the decrypted combination code to determine whether the non-random portion is correct or obtain tracking information. However Gilham does teach this step (fig. 4: "Decrypt and Check Validation). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate this step into the system of Storch and Venkatesan. Motivation to make this combination is found for example, at col. 16 lines 5-8, where Storch discusses the desirability of providing ID numbers verifiable by a secret algorithm

As for claims 104-107, the claims represent the computer program product embodied in a memory medium that causes a computer to carry out the method of claims 77 and 97 when executed. Therefore claims 104-107 are rejected on the same basis as claims 77 and 97.

Allowable Subject Matter

11.   Claims 100 and 101 are allowed.

12.   Claims 53-60, 62, 64, 87, 94-96, 106, and 107, are objected to as being

dependent upon a rejected base claim, but would be allowable if rewritten in

independent form including all of the limitations of the base claim and any intervening

claims.

Conclusion

13.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Paul E. Callahan whose telephone number is (571) 272-

3869. The examiner can normally be reached on M-F from 9 to 5.

        If attempts to reach the examiner by telephone are unsuccessful, the Examiner's

supervisor, Andrew Caldwell, can be reached on (571) 272-3868. The fax phone

number for the organization where this application or proceeding is assigned is: (703)

872-9306. Any inquiry of a general nature or relating to the status of this application or

proceeding should be directed to the receptionist whose telephone number is (703) 305-

3900.

05-14-2005

Paul Callahan